

REMARKS/ARGUMENT

The Examiner has rejected claims -3, 5, and 7-18 under 35 U.S.C. 102(b) as being anticipated by Kawasaki, et al., U.S. Patent No. 5,486,194 (hereinafter "Kawasaki") As noted by the Examiner, 35 U.S.C. 102(b) states that:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Therefore, Applicant's invention will be unpatentable only if each and every element claimed in the application is disclosed by Kawasaki.

Kawasaki does not disclose each and every element of Applicant's invention. The Examiner asserts generally that Kawasaki teaches a device capable of prevention of abnormal joint rotation. However, there is no supporting evidence of this assertion. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1990) (quoting Hansgirk v. Kemner, 102 F.2d 212, 214 (C.C.P.A. 1981) (emphasis added). There is absolutely nothing in the teaching disclosed by Kawasaki to indicate that it is capable of doing anything remotely similar to the correcting pressure achieved by Applicant's device. The Examiner has cited to no figure or page number to support the assertion, and the reason for this is simply that none exists. Therefore, there can be no anticipation based on the unsupported assertion that the band of Kawasaki is capable of countering the direction of the abnormal joint rotation. It shall also be noted that there are no specific 102(b) rejections made for claims 1-3, 5, or

8-12 other than the general comments on page 2. Regardless, the arguments contained herein should be sufficient to overcome any rejections of these claims, whether general or specific.

With regard to claim 7, Kawasaki claims a band made of non- or low-stretchable fiber. Applicant's claim 7 recites an "elastic material." Therefore, Kawasaki teaches an element that is distinctly different from elastic, i.e. non or low stretchable fiber. The limitation of Kawasaki, thus, can not be said to meet the "each and every element" requirement of 35 U.S.C. 102(b).

Regarding claim 13, the Examiner's contention that Kawasaki includes an appendage securing section that has a first end and a second end, and a torso securing section that has a first end, and intermediate section and a securing end is simply not accurate. To the contrary, Kawasaki discloses a single band that has one end that includes projections, and the other end portion of the band that can be thrust on said projections. Kawasaki, col. 4, lines 50-55, and col. 17, line 10. Because the band of Kawasaki is limited to a single band with only two ends, it is impossible for Kawasaki to disclose an appendage securing section that has a first end and a second end, and a torso securing section that has a first end, and intermediate section and a securing end. Therefore, Kawasaki does not anticipate these elements of Applicant's invention.

Applicant's invention, as recited in claim 16 discloses the addition of a coupling means to the device. Claim 18 discloses that the device may be joined together to form a single band wrap. These embodiments, along with simple claim differentiation principles illustrate once again that Kawasaki does not come close to teaching Applicant's invention. As claimed and depicted in Applicant's drawings, figures 1-4, the torso

section and the appendage section are separate elements. Kawasaki claims a single band, therefore, the anticipation analysis may end with claim 1 of Kawasaki. The dependent status of the remainder of Applicant's claims make them immune to any possibility of anticipation by Kawasaki as well, because if the independent claim elements are not anticipated, claims depending therefrom can not be anticipated either.

The Examiner has rejected claims 4, 6, 19 and 20 as being unpatentable under 35 U.S.C. 103(a). As noted by the Examiner, 35 U.S.C. 103(a) states that:

a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Therefore, Applicant's invention will be unpatentable if the differences between it and the information disclosed in the patents cited are such that Applicant's invention would have been obvious.

The Examiner has rejected claim 4 as being unpatentable over Kawasaki in view of U.S. Patent No. 5,993,375 to Engel (hereinafter "Engel"). The Examiner's argument is valid if, and only if, the previous arguments with regard to the disclosure of Kawasaki are valid. As has been shown, the disclosure of Kawasaki is so divergent from Applicant's invention that the simple addition of Engel, a patent that discloses the use of magnets, can not render Applicant's invention obvious.

The Examiner has rejected claim 6 as being obvious because Kawasaki's device could arguably be used on a shoulder joint. This argument has merit as far as it goes, but Kawasaki's device, wrapped around the shoulder, would not prevent any shoulder joint rotation, normal or abnormal, any more than it would prevent hip rotation. Therefore, it

is immaterial whether the device of Kawasaki could potentially be wrapped around the shoulder. Furthermore, there would be no motivation to wrap the device of Kawasaki around the shoulder, because the primary purpose of the device is to apply hemostatic pressure to a wound via a balloon. The type of catheter wound contemplated for treatment by Kawasaki simply does not occur in the shoulder region.

With respect to claim 19, the Examiner argues that Figure 5A of Kawasaki teaches the steps recited in claim 19. In reality, Figure 5A helps demonstrate the differences between the two devices that render Applicant's device both novel and nonobvious. Specifically, in direct contrast to the Examiner's statement, Kawasaki does not show the step of wrapping the appendage securing section of the wrap at least once around the thigh prior to wrapping around the torso securing section. Kawasaki shows only an X-shaped single band wrap. This configuration simply does not provide the corrective pressure necessary for counteracting abnormal joint rotation, nor does it include the step of wrapping around the thigh. It surely does not provide the corrective pressure for the internal and external rotations claimed by Applicant. Generally speaking, Kawasaki simply provides a wrap that secures the portion of the device designed to apply pressure to a wound, and simply claiming that it is capable of exerting corrective pressures for abnormal joint rotation does not make it so.

The same facts and corresponding arguments apply to the Examiner's rejection of claim 20. The wrap of Hori, et al. U.S. Patent No. 5,464,420 (hereinafter "Hori") is not wrapped at least once around the thigh prior to attaching to the torso securing section. Similar to the device of Kawasaki, the device of Hori is wrapped in an X-shaped fashion, around the thigh, and does not include an initial revolution around the thigh as claimed

and illustrated by Applicant's invention. More importantly, the device of Hori is simply incapable of providing the corrective forces necessary to prevent the abnormal joint rotation as provided by Applicant's device.

Reconsideration and further examination is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

In the event that an extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Patrick D. Archibald, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above remarks and arguments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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| <u>Aug. 30, 2005</u> | <u>Patrick D. Archibald</u> |
| Date | Patrick D. Archibald |
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